

REMARKS

The application includes claims 1-30 prior to entering this amendment.

The examiner objected to claim 21 because of informalities.

The examiner rejected claims 1, 2, 5, 6, 10-15, 17, 21, 22, and 25-28 under 35 U.S.C. § 102(e) as being anticipated by Toyoda (U.S. Patent No. 6,330,070).

The examiner rejected claims 3, 4, 7, 8, 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Toyoda in view of Mori (U.S. Patent No. 6,417,930).

The examiner objected to claims 9, 16, 18-20, 23, and 24 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The applicant amends claims 1, 3-5, 9-13, 16-19, 21-24, 26, 28 and 30.

The applicant cancels claims 2, 25 and 27 without prejudice.

The applicant adds new claims 31-33.

The application remains with claims 1, 3-24, 26, 28-33 after entering this amendment.

The applicant makes the above amendments without prejudice or disclaimer. The applicant makes the amendments to delineate more clearly intended subject matter. Accordingly, the applicant does not intend to surrender claimed subject matter by submission of the above amendments and does not add new matter. The applicant respectfully requests reconsideration of the above referenced patent application in view of the following remarks.

Claim Objections

The examiner objected to claim 21 because of informalities. The applicant amends claim 21 to obviate the examiner's objections.

Claim Rejections Under § 102

The examiner rejected claims 1, 2, 5, 6, 10-15, 17, 21, 22, and 25-28 as being anticipated by Toyoda. The applicant traverses the rejection for the reasons that follow.

Amended claim 1 recites:

a database to store a fax number of the fax recipient where the fax number is to be associated with information corresponding to the e-mail

message where the information corresponding to the e-mail message is independent of the fax number; and

at least one fax modem device for transmitting the fax document to the fax recipient through a public switching network, where the fax number designating the fax recipient is to be obtained separately from the e-mail message by associating the information corresponding to the e-mail message with the fax number stored in the database.

With regard to claim 1, the examiner indicates:

(b) at least one the modem device for transmitting the fax document to the fax recipient through a public switching network, wherein a fax number designating the fax recipient is obtained of separately from the e-mail (see Fig. 2, element 28, col. 3, lines 13-15).¹

The portion of Toyoda noted by the examiner states:

Modem 28 modulates/demodulates data transmitted/received to/from the telephone line, and network control unit 29 controls the telephone line.²

The portion of Toyoda cited by the examiner merely discloses a modem element (as shown in Figure 2 of Toyoda) with no discussion of designating a fax number for a fax recipient. The applicant submits that Toyoda does not disclose “a fax number designating the fax recipient ... obtained separately from the e-mail message,” as is disclosed in claim 1 of the current application. On the contrary, Toyoda discloses a communication apparatus for securely relaying an Internet facsimile which distinguishes between public e-mail messages and Internet facsimile request messages by recognizing different passwords inserted into the recipient mail address of the message.³ In the case of an Internet facsimile request, the fax number (called the ‘destination telephone number’ in Toyoda) is provided in the requesting e-mail message.⁴ Further, in Toyoda an Internet facsimile is sent only if the relay mail address provided in the requesting e-mail matches a stored relay mail address and the domain name of the apparatus transmitting the e-mail request is recognized.⁵ Thus, in Toyoda, in order to transmit an Internet facsimile the fax

¹ Office Action, page 3.

² Toyoda, col. 3, lines 13-15.

³ Toyoda, col. 3, lines 50-62.

⁴ Toyoda, col. 3, lines 63-67 and col. 4, lines 31-49.

⁵ Toyoda, Abstract, Fig. 7, element S703, col. 3, lines 50-62, col. 4, lines 1-8 and lines 27-59 and col. 5, line 53- col. 6, line 3.

number of the recipient device must be provided in the requesting e-mail.⁶ Toyoda does not disclose any other method of discerning a fax number for a fax recipient other than by receiving the fax number in the requesting message.

In contrast, in claim 1 of the current application, the fax number designating the fax recipient is obtained separately from the e-mail message by associating information corresponding to the e-mail message with the fax number stored in a database where the information corresponding to the e-mail message is independent of the fax number. Moreover, because the applicant's device is capable of transmitting a fax document to a fax recipient where the fax number is not provided in the requesting e-mail the process can be transparent to the sender. In other words, the sender of the e-mail message may not be aware that a message sent as an e-mail is transmitted to the recipient as a fax document.⁷ Nothing in Toyoda teaches the fax number designating the fax recipient is obtained separately from the e-mail message by associating information corresponding to the e-mail message with the fax number stored in a database where the information corresponding to the e-mail message is independent of the fax number.

Assuming, for the sake of argument, that Toyoda discloses *a fax number designating the fax recipient obtained separately from the e-mail message*, Toyoda still does not disclose all of the elements of amended claim 1. For instance, at least Toyoda does not disclose "a database to store a fax number of the fax recipient where the fax number is to be associated with information corresponding to the e-mail message where the information corresponding to the e-mail message is independent of the fax number." In Toyoda, registered fax numbers are stored for comparing to destination fax numbers provided in the e-mail messages.⁸ This is not the same as comparing information corresponding to the received e-mail message *where the information corresponding to the e-mail message is independent of the fax number* as is disclosed in claim 1.

For at least these reasons, claim 1 and its dependent claims 5, 6, 10-15 and 26 are allowable over Toyoda and the applicant requests allowance.

Independent claims 17, 21 and 22 are allowable over Toyoda on the same or similar basis as claim 1 and the applicant requests allowance.

⁶ Toyoda, Abstract, Fig. 7, element S703, col. 3, lines 50-62, col. 4, lines 1-8 and lines 27-59 and col. 5, line 53- col. 6, line 3.

⁷ Specification, page 19, lines 3-10.

⁸ Toyoda, col. 3, line 23-26.

Claim 28 depends from claim 17 and is allowable over Toyoda on the same or similar basis as claim 17 and the applicant requests allowance.

Claims 2, 25 and 27 are canceled.

The applicant believes that the claimed subject matter is patentably distinguishable from Toyoda for additional reasons; however, because the forgoing is believed to be sufficient, the applicant chooses to omit them at this time. Likewise, the applicant's failure to comment directly upon any of the positions asserted by the examiner in the current office action does not indicate agreement or acquiescence with those asserted positions. Rather, the examiner's positions are rendered moot by the foregoing and, therefore, it is not necessary to respond to every position taken by the examiner with which the applicant does not agree.

Claim Rejections Under § 103

The examiner rejected claims 3, 4, 7, 8, 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Toyoda in view of Mori (U.S. Patent No. 6,417,930).

Claims 3, 4, 7, 8, 29, and 30 depend from claims 1 or 17 and distinguish from Toyoda on at least the same or similar basis as discussed above. Mori does not cure the deficiencies of Toyoda. In particular, similar to Toyoda, Mori discloses a network facsimile apparatus for relaying e-mail to a facsimile machine that reads a telephone number of a destination facsimile machine from the received relay transmission mail.⁹ Like Toyoda, nothing in Mori teaches the fax number designating the fax recipient obtained separately from the e-mail message, as is disclosed in claims 1 and 17 and the respective dependent claims 3, 4, 7, 8, 29, and 30 and of the current application.

For at least these reasons, claims 3, 4, 7, 8, 29, and 30 are allowable over Toyoda in view of Mori and the applicant requests allowance.

The applicants believe that the claimed subject matter is patentably distinguishable from Toyoda and Mori for additional reasons; however, because the forgoing is believed to be sufficient, the applicant chooses to omit them at this time. Likewise, the applicant's failure to comment directly upon any of the positions asserted by the examiner in the current office action does not indicate agreement or acquiescence with those asserted positions. Rather, the

⁹ Mori, Abstract, col. 1, lines 60-62, col. 2, lines 18-19 and lines 42-44.
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examiner's positions are rendered moot by the foregoing and, therefore, it is not necessary to respond to every position taken by the examiner with which the applicant does not agree.

Claims Allowable

The examiner objected to claims 9, 16, 18-20, 23, and 24 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The applicant thanks Examiner Sam for acknowledging the allowability of these claims.

The applicant herein amends claims 9, 16, 18-19, 23, and 24 to include all the elements of the respective rejected base claim and any intervening rejected claim. These amendments are made based on the previously pending claims 1-30. The applicant does not amend claim 20 as it depends from amended claim 19 and thus includes all of the elements of claim 2 and any intervening claim. Accordingly, all of claims 9, 16, 18-20, 23, and 24 are in condition for the examiner's allowance for at least this reason.

New claims

The applicants submit new claims 31-33 that depend from claim 17 and distinguish from Toyota on at least the same or similar basis as claim 17. Additionally, the specification supports the new claims 31-33 in various portions.¹⁰

¹⁰ E.g., Specification, page 22, line 16 and page 23, lines 4-11.
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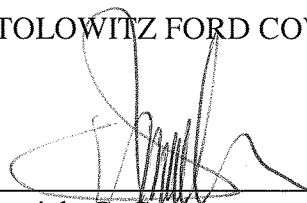
Conclusion

For the foregoing reasons, the applicant requests reconsideration and allowance of the remaining claims. The applicant encourages the examiner to telephone the undersigned at (503) 224-2170 if it appears that an interview would be helpful in advancing the case.

Customer No. 73552

Respectfully submitted,

STOLOWITZ FORD COWGER LLP

A handwritten signature in black ink, appearing to read 'Graciela G. Cowger', is written over a horizontal line.

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